



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/171,553 02/08/99 GALBRAITH

D CFV-005.01

EXAMINER

HM12/0419

PATENT GROUP
FOLEY HOAG & ELIOT
ONE POST OFFICE SQUARE
BOSTON MA 02109

SHUKLA, R

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

6
04/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/171,553

Applicant(s)

GALBRAITH ET AL.

Examiner

Ram R Shukla

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1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-5, 8-24, and 26-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-5, 8-24, and 26-33 are pending in the instant application.
2. **Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

The specification discloses nucleotide and amino acid sequences in figures, claims, and disclosures of the specification. For compliance with sequence rules, it is necessary to include the sequence in the "Sequence Listing". In general, any sequence that is disclosed and/or claimed as a sequence, i.e., as a string of particular bases or amino acids, and that otherwise meets the criteria of 37 CFR 1.821(a), must be set forth in the "Sequence Listing." (see MPEP 2422.03).

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 8-10, 12, 17, 19-24, and 29-30, drawn polynucleotides and uses thereof, classifiable in class 536, subclass 23.1.

Group II, claim(s) 11, 13-16, 27, and 29-30, drawn to polypeptides and uses thereof, classifiable in class 530, subclass 350.1.

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Group III, claim(s) 18, 28, and 29-30, drawn to antibodies and uses thereof, classifiable in class 530, subclass 387.1.

Group IV, claim(s) 26, 29-30, 32, and 33, drawn to transgenic animals, classifiable in class 800, subclass 8.

4. Claims 29-30 encompasses subject matter of the inventions of groups I, II, and III. Should any of these groups be elected, claim 29 will be examined to the extent it encompasses the elected invention.

5. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The inventions of groups I, II, III, and IV are drawn to nucleic acids, proteins, antibodies and transgenic animals respectively, that are compositions of materially different physical and chemical properties, and utilities. All these inventions lack same special technical features because the invention of group I recites polynucleotides that encodes at least one porcine retrovirus expression product which would indicate that it can encode more than one product, therefore, the expression product of group I invention may not be essentially same as the polypeptide of group II. Furthermore, the invention of group II comprises multitude of polypeptides, which may have different function from each other because of the difference in the polynucleotide sequences encoding them. Likewise, the invention of group III, antibodies, may lack the same special technical features as those of group I and II because the antibodies raised against one protein may not recognize all the proteins of the group II or all the proteins encoded by all the polynucleotides of the group I. Finally, the invention of group IV will also lack the same special technical feature as those of groups I, II, and III because the phenotypes of a transgenic animal may change based on the protein it encodes, and will depend on several factors, including the vector, site of expression, stage of development of expression etc., in addition to the polynucleotides. Therefore, the inventions of the groups I-IV lack the same or corresponding special technical features.

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6. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, lack same special technical features, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on 8-5:30 Mon-Thurs and 8-4:30 alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine C Chambers can be reached on (703) 308-2035. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.

Jasmine C. Chambers
JASEMINE CHAMBERS
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